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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,862	12/20/2000	Jonathan Spetner	7727	7603
1688	7590	12/31/2003	EXAMINER	
POLSTER, LIEDER, WOODRUFF & LUCCHESI 763 SOUTH NEW BALLAS ROAD ST. LOUIS, MO 63141-8750			GARCIA, ERNESTO	
			ART UNIT	PAPER NUMBER
			3679	

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/742,862

Applicant(s)

SPETNER ET AL.

Examiner

Ernesto Garcia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

Claims 1, 4, 9, 18 and 19 are objected to because of the following informalities:

regarding claim 1, the limitation "and/or" in line 1 and 7 should be --and--, the limitation --is-- should be inserted after "system" in line 5, the limitation --the-- should be inserted after "to" in line 7, and the limitation "further comprising" in line 12 is inaccurate as there is no indication that the computer system was previously comprised of any feature before line 12; and,

regarding claim 4, the limitation "with" in line 4 should be --, the--;

regarding claim 9, "further" in line 16 should be deleted and "and/or" in lines 1 and 9 should be --and--;

regarding claim 18, the limitation --the-- should be inserted before "goods" in lines 4 and 5, "and/or" in lines 1, 4, 5 should be --and--, the first occurrence of --the-- in line 8 should be deleted, and "with" in line 9 should be replaced by a comma;

regarding claim 19, "a" in line 2 should be --the--; and,

regarding claim 20, "or" in line 2 should be --and--. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 10, it is unclear whether the computer is the customer computer or the vendor computer. For examination, the examiner has considered the computer to be the customer computer.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 7-9, 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Agostino, 5,231,571.

Regarding claim 1, D'Agostino discloses a system comprising a computer **14**, a computer system **12**, a telephone connection **16** between the computer **14** and the computer system **12**. The computer system **12** comprises a means **72** for controlling operation of the computer **14**. The means **72** for controlling comprises different levels of control (col. 4, lines 43-46 states that the computer system 12 controls a display of the customer's terminal so that appropriate options are displayed at the customer's terminal; (col. 4, lines 59-62; states that the computer system 12 controls the customer's terminal to cause a completed form to be printed for the customer).

Applicant is reminded that computer 14 is able to access an Internet. The computer system 2 is able of being accessed by the computer over the internet. The computer system is for providing screens to the computer once the computer accesses the computer system with such screens able to provide information and a phone number. The information relates to the products and services being offered for sale by the computer system. The phone number is for contacting a representative of the computer system.

Regarding claim 7, a representative is capable of inputting information to be displayed on the computer capable of accessing an Internet.

Regarding claims 8 and 17, the computer system **12** further comprises a computer having a display **44** having a first window which is representative of a screen provided to the computer and a second window containing other information (col. 13, line 68 to col. 14, line 2). The first window and the second window being displayed simultaneously in the display.

Regarding claim 9, D'Agostino discloses a system comprising a customer computer **14**, a customer telephone **30A**, a vendor computer system **12**, a vendor telephone **52**, and a telephone connection **16** between the customer telephone **30A** and the vendor telephone **52**. The computer system **12** further comprises a means **72** for controlling operation of the customer computer **14**. The means **72** for controlling comprises different levels of control (col. 4, lines 43-46 states that the computer system **12** controls a display of the customer's terminal so that appropriate options are displayed at the customer's terminal; (col. 4, lines 59-62; states that the computer system **12** controls the customer's terminal to cause a completed form to be printed for the customer).

Applicant is reminded that the customer computer is able to access an internet. The vendor computer is able to being accessed by the customer computer over the internet. The vendor computer system is for providing a series of screens to the customer computer once the customer computer accesses the vendor computer system

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with such screens able to provide information relating to products and services being offered for sale by the vendor computer system and a phone number for contacting a representative of the vendor computer system.

Regarding claim 16, a representative is able to input information to be displayed on the customer computer **14**.

Claims 1-4 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Thean et al., 6,397,036.

Regarding claim 1, Thean et al. disclose in Figure 2 a system comprising a computer **30**, a computer system **14**, a telephone connection (the hatched arrows aligned on top) between the computer **30** and the computer system **14**. The computer system **14** comprises a means (the operating system, OS) for controlling operation of the computer **30**. The means (the OS) for controlling comprises different levels of control (the control panels for controlling settings of the operating system).

Applicant is reminded that computer 30 is able to access an Internet. The computer system 14 is able of being accessed by the computer over the internet. The computer system is for providing screens to the computer once the computer accesses the computer system with such screens able to provide information and a phone number. The information relates to the products and services being offered for sale by

the computer system. The phone number is for contacting a representative of the computer system (col. 1, lines 65-66).

Regarding claims 2 and 10, the computer **30** has a web enabled program (Internet Explorer) and one level of control (preferences control of the web enabled program). Applicant is reminded that the one level of control is able to control operation of the web enabled program.

Regarding claims 3 and 11, the computer system **14** further comprises a software program (col. 2, lines 9-13). Applicant is reminded the software program is able to generate a quote based upon displayed information and able to send the quote to the web enable program.

Regarding claim 4, one level of control is able to send information from the computer system to the computer. The information includes an audio file, a video clip, or a slide show presentation (col. 4, lines 56-60).

Regarding claim 9, Thean et al. disclose in Figure 2 a system comprising a customer computer **30**, a customer telephone (Thean's invention envisions the use of a telephone, see col. 1, lines 65-66), a vendor computer system **14**, a vendor telephone, and a telephone connection (shown by the hatched arrows horizontally aligned on top of Figure 2) between the customer telephone and the vendor telephone. The computer



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system **14** further comprises a means (the operating system, OS) for controlling operation of the customer computer **30**. The means for controlling comprises different levels of control (control panels control how the computer is operated).

Applicant is reminded that the customer computer is able to access an internet. The vendor computer is able to being accessed by the customer computer over the internet. The vendor computer system is for providing a series of screens to the customer computer once the customer computer accesses the vendor computer system with such screens able to provide information relating to products and services being offered for sale by the vendor computer system and a phone number for contacting a representative of the vendor computer system.

Regarding claim 12, as best understood, one of the levels of control includes able to send information from the computer system to the computer. The information includes an audio file, a video clip, or a slide show presentation (col. 5, lines 57-60). This can also be a file transfer protocol (FTP).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 6, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Agostino, 5,231,571.

Regarding claims 5 and 13, D'Agostino, as discussed above, discloses the telephone connection **16** not being wireless connection. Applicant is reminded that wireless connections have been known for years. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to convert the telephone connection **16** into a wireless connection.

Regarding claims 6 and 14, D'Agostino, as discussed above, fail to disclose the computer **14** being a hand held computer. Applicant is reminded that laptop computer, a hand held computer, has been known before applicant's filling date 12/20/00. D'Agostino has suggested that other computers may be used instead of the IBM PS/2 Model 55SX (col. 8, lines 29-31; col. 18, lines 13-18). Therefore, one of ordinary skill in the art would replace the 386SX old technology with modern computers including a laptop computer.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thean et al., 6,397,036, in view of Szymansky, 6,557,029.

Regarding claim 15, Thean et al., as discussed above, fails to disclose the customer computer **30** being a wireless hand held computer. Thean et al. do not specify details of the computers used in the invention. It appears that one of ordinary skill in the art will most likely use a desktop computer with Thean's invention and later expand to include wireless hand held computers that include a laptop (hand held computer) with a wireless communication system or a PDA also with a wireless communication system as shown in Figure 1 to send messages between a customer and a representative. Therefore, as taught by Szymansky, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a wireless hand held computer instead of an ordinary desktop computer to transfer messages between the customer and the representative.

Claim 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gifford, 5,724,424.

Regarding claim 18, Gifford discloses a method of marketing goods and services over an Internet, the method comprises:

- provide a website of a vendor over the Internet;
- allow a customer to access the website by using a customer computer to view screens relating to goods services offered by the vendor; and,
- display the goods or services;

control operation of the screens presented to the customer computer (web browsers are known to control how information is displayed and retrieved from an html file); and the step of

control having different levels of control (web browsers have been known to allow a customer to display a webpage in a different font than the webpage's default font, and it is well known to control visited hyperlinks in the webpage by either changing text depicting the hyperlinks by color and underlining).

However, Gifford fails to connect a telephone call between the customer and a representative of the vendor.

Applicant is reminded that connecting a telephone call between the customer and a representative of the vendor is well known as websites often place customer service phone number for obtaining assistance on how to operate the screens presented to the customer, for getting more information about a product or products, or for placing an order for the product or products over a phone.

Regarding claim 19, Gifford, as modified, above, fails to include a representative input information to be presented to the customer. Applicant is reminded that if the customer called the representative of the vendor to order the product or products, the representative will input information to be presented to the customer at a later time in a bill statement.

Regarding claim 20, Gifford teaches the method further includes finalizing a purchase. Applicant is reminded that when a customer calls to make an order to the representative, the customer finalizes the purchase by giving permission to charge a credit card.

### ***Response to Arguments***

Applicant's arguments filed 12/20/00 have been fully considered but they are not persuasive.

Applicant has argued that D'Agostino does not include a controlling means comprising different levels of control. As far as applicant has not shown these features in the system, D'Agostino teaches a controlling means as well.

Applicant has argued that D'Agostino's computer 14 is not capable of accessing the internet. The examiner has considered D'Agostino's computer able to access the internet by definition. According to the 10<sup>th</sup> edition of Merriam-Webster's Collegiate Dictionary, an internet: is an electronic communications network that connects computer networks and organizational computer facilities around the world. Therefore, the customer's terminals and the representative's terminal form a communications network. One customer terminal is a computer network and the financial institutions are the

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organizational computer facilities. Furthermore, applicant has argued that neither computer 12 is able to access the internet. This is not found persuasive since Figure 3B shows each computer 12 and 14 having each a modem 26 and 48. As far as computers have been known to have a modem, computers with a modem can access the internet.


The examiner has noted the reference made to column 5, lines 11-20 of D'Agostino by applicant to indicate that the customer terminal does not act like a computer. D'Agostino concept teaches the terminal not serving the customer as a computer as the customer does not control or use the keyboard 25 which the keyboard 25 is hidden from the customer (col. 7, lines 62-66), but instead the terminal serves for watching information displayed by the representative. Despite the keyboard being hidden, the customer terminal is a computer (see col. 7, lines 51 to col. 8, line 28). The customer just cannot use it as an ordinary compute since the keyboard is not provided to the customer.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

  
**Lynne H. Browne**  
**Supervisory Patent Examiner**  
**Technology Center 3600**

E.G.

December 15, 2003